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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,178	01/24/2005	Toshio Shimizu	040894-7167	3575
9629	7590	03/06/2006	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			NASH, BRIAN D	
			ART UNIT	PAPER NUMBER
			3721	
DATE MAILED: 03/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/522,178	Applicant(s) SHIMIZU ET AL.	
	Examiner Brian Nash	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/24/05, 11/10/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. Figures 10(a-d) should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because the numerals should be contained in parentheses. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 7, the terminology “strike passage” is indefinite because it is not clear what applicant is claiming or what limitations are encompassed by the claim. Specifically, applicant has defined a “strike out passage” previously in the claim and unless applicant is claiming a separate element, such reference to this “passage” should be consistent and be defined as a “strike out passage” throughout the claims.

In claims 1 and 3, the terminology “inner side” is indefinite because it is not clear what applicant is claiming or what limitations are encompassed by the claim. Specifically, it is not clear if an “inner side” refers to one of the staple legs or an “inner side” describes a side of the guide member located within the inside of the stapler. The examiner has construed the claims to define a guide member that supports a portion of the staple leg from an inner side of the stapler during the stapling process.

With respect to claim 3, line 10, it is not clear what comprises a guide member. Specifically, is claim 3 defining a combination stapler and cartridge wherein the stapler comprises a guide member as claimed in the last paragraph of claim 3 or does applicant intend for claim 3 to define a combination stapler and cartridge wherein the cartridge itself comprises a guide member as claimed in the last paragraph of claim 3. The examiner has construed claim 3 to define the former.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3721

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by US

6,209,772 to Wang. Wang shows the same invention as claimed:

With respect to claims 1 and 3, a stapler and cartridge combination comprising a strike out passage (243) for guiding staples (5) into sheets (6) wherein the staple legs are folded to bend in right angles from both ends of a crown portion of the staple; a driver plate (111) for striking out the staples through the strike out passage and into the sheets; a clincher mechanism (31, 311) arranged to oppose the driver plate for folding the staples along a rear face of the sheets; and a guide member (123) for supporting a side of a base portion of the staple leg from an inner side of the stapler during the process that the staple legs penetrate the sheets (see column 3, lines 1-10 & column 4, lines 1-5, Figs. 1-5a,b). The additional cartridge claimed in 3 is shown in Figs. 4 & 5a wherein the staples (5) are in a cartridge that is mounted into a cartridge basket (24) of the stapler assembly.

With respect to claim 2, the guide member (123) includes a guide piece disposed in the strike out passage (see Figs. 5a,b, not separately numbered) and an inclined face formed to the guide piece (column 4, lines 6-16); and wherein the guide member (123) moves in the direction of escaping from the strike out passage and the inclined face is brought into contact with the crown portion of the staple.

With respect to claim 5, Wang shows the stapler and cartridge combination wherein the guide member (123) includes a guide piece disposed in the strike out passage (see Figs. 5a,b, not

separately numbered) and an inclined face formed to the guide piece (column 4, lines 6-16); and wherein the guide member (123) moves in the direction of escaping from the strike out passage and the inclined face is brought into contact with the crown portion of the staple.

8. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,651,491 to Heaton et al. Heaton et al show the same invention as claimed:

With respect to claims 1 and 3, a stapler and cartridge combination comprising a strike out passage (slots shown in cartridge 22, not numbered – see Fig. 6) for guiding staples (24) into tissue sheets wherein the staple legs are folded to bend in right angles from both ends of a crown portion of the staple; a plurality of driver plates (26) for striking out the staples through the strike out passage and into the tissue sheets; a clincher mechanism (anvil 90, 91 – see Fig. 12) arranged to oppose the driver plates for folding the staples along a rear face of the sheets; and a guide member (slot wall seen in Fig. 6b, not numbered) for supporting a side of a base portion of the staple leg from an inner side of the stapler during the process that the staple legs penetrate the tissue sheets. The additional cartridge (22) claimed in 3 is shown in Fig. 6 wherein the staples (24) are in a disposable cartridge that is mounted to the stapler assembly.

With respect to claim 4, the guide member (slot wall seen in Fig. 6b, not numbered) is integrally molded to be single-piece with the cartridge (22).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Henry, Merrill, Green et al, Harris et al, Huang, Racenet et al, Brinkerhoff et al, Alesi et al, Sugihara et al and Jairam are cited to show related references.

Art Unit: 3721

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 6 p.m.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467. The official fax number for this Group is: 571-273-8300

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/1/2006



Brian Nash
Patent Examiner
Art Unit 3721